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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Thomas Odorzynski Art Unit: 3622
Serial No. 10/748,715
Filed December 30, 2003
Confirmation No.: 2119
For: SELLING AD SPACE ON DIAPERS
Examiner James W. Myhre

March 10, 2008

AMENDMENT A

TO THE ASSISTANT COMMISSIONER FOR PATENTS,
SIR/MADAM:

This Amendment A is submitted in response to the Office action mailed December 26, 2007. Please consider the amendments and remarks made herein.

Amendments to the Claims are shown in the Listing of Claims which begins on page 2 of this paper.

Remarks begin on page 8 of this paper.

Conclusion begins on page 16 of this paper.

Listing of Claims:

1. (Currently Amended) A method of advertising, the method comprising:

selling space on a disposable diaper ~~diapers~~ to a sponsor;
and

placing an ad for a product other than disposable diapers onto the disposable diaper ~~diapers~~.

2. (Cancelled).

3. (Currently Amended) The method of claim 1 further comprising selling the disposable diaper ~~diapers~~ to customers.

4. (Currently Amended) The method of claim 1 wherein the ad is a first ad, the product is a first product and the sponsor is a first sponsor, and wherein ~~such~~ the method further comprises:

selling space on the disposable diaper ~~diapers~~ to a second sponsor; and

placing a second ad for a second product other than disposable diapers onto the disposable diaper ~~diapers~~.

5. (Currently Amended) The method of claim 4 wherein placing the first ad onto the disposable diaper ~~diapers~~ includes placing the first ad on a front of the disposable diaper ~~diapers~~, and placing the second ad onto the disposable diaper ~~diapers~~ includes placing the second ad on a back of the disposable diaper ~~diapers~~.

6. (Currently Amended) The method of claim 1 wherein placing the ad onto the disposable diaper ~~diapers~~ includes printing the ad onto the disposable diaper ~~diapers~~.

7. (Currently Amended) The method of claim 1 wherein placing the ad onto the disposable diaper ~~diapers~~ includes affixing a detachable ad onto the disposable diaper ~~diapers~~.

8. (Currently Amended) A system for generating advertising revenue comprising:

a disposable diaper ~~diapers~~; and
an ad[ads] for products other than disposable ~~diapers~~
placed onto the disposable diaper ~~diapers~~.

9. (Cancelled).

10. (Currently Amended) The system of claim 8 wherein ~~each~~
~~of the~~ disposable diaper ~~diapers~~ includes a first ad on a front
of the disposable diaper ~~diapers~~ and a second ad on a back of
the disposable diaper ~~diapers~~.

11. (Currently Amended) The system of claim 10 wherein the
first ad is for a first product other than disposable diapers
and the second ad is for a second product other than disposable
diapers.

12. (Currently Amended) The system of claim 8 wherein the
ad is ~~ads are~~ printed onto the disposable diaper ~~diapers~~.

13. (Currently Amended) The system of claim 8 wherein the
ad is ~~ads are~~ detachable from the disposable diaper ~~diapers~~.

14. (Currently Amended) A method of promoting product
purchases, the method comprising:

placing a promotion relating to purchasing the product onto
a disposable diaper ~~diapers~~; and

selling the disposable diaper ~~diapers~~ to a
customer~~customers~~.

15. (Currently Amended) The method of claim 14 further comprising manufacturing the disposable diaper ~~diapers~~.

16. (Currently Amended) The method of claim 14 wherein placing a promotion onto the disposable diaper ~~diapers~~ includes placing a promotion relating to purchasing disposable diapers onto the disposable diaper ~~diapers~~.

17. (Currently Amended) The method of claim 14 wherein placing a promotion onto the disposable diaper ~~diapers~~ includes placing a promotion relating to purchasing a product other than disposable diapers onto the disposable diaper ~~diapers~~.

18. (Currently Amended) The method of claim 14 wherein placing a promotion onto the disposable diaper ~~diapers~~ includes placing a coupon for purchasing the product onto the disposable diaper ~~diapers~~.

19. (Cancelled).

20. (Currently Amended) The method of claim 14 wherein placing a promotion onto the disposable diaper ~~diapers~~ includes selling space on the disposable diaper ~~diapers~~ to a sponsor to place the promotion onto the disposable diaper ~~diapers~~.

21. (Cancelled).

22. (Currently Amended) A system for promoting product purchases, the system comprising:

a disposable diaper ~~diapers~~; and
a promotion~~promotions~~ related to purchasing the
product~~products~~, the promotion~~promotions~~ being placed onto the
disposable diaper ~~diapers~~.

23. (Cancelled).

24. (Currently Amended) The system of claim 22 wherein ~~each of the~~ disposable diaper ~~diapers~~ includes a first promotion on a front of the disposable diaper ~~diapers~~ and a second promotion on a back of the disposable diaper ~~diapers~~.

25. (Currently Amended) The system of claim 22 wherein the ~~promotion~~~~promotions~~ relates to purchasing disposable diapers.

26. (Currently Amended) The system of claim 22 wherein the ~~promotion~~~~promotions~~ relates to purchasing products other than disposable diapers.

27. (Currently Amended) The system of claim 22 wherein ~~each of the~~ disposable diaper ~~diapers~~ includes a first promotion that is related to purchasing a product other than disposable diapers and a second promotion that is related to purchasing disposable diapers.

28. (Currently Amended) The system of claim 22 wherein the ~~promotion is~~~~promotions are~~ printed onto the disposable diaper ~~diapers~~.

29. (Currently Amended) The system of claim 22 wherein the ~~promotion is~~~~promotions are~~ detachable from the disposable diaper ~~diapers~~.

30. (Cancelled).

REMARKS

Claims 1, 3-8, 10-18, 20, 22, and 24-29 have been amended in this Amendment B. Specifically, the claims have been amended to require the diaper to be a disposable diaper. Support for this amendment can be found in the instant Specification on page 1, lines 7-13 and lines 22-24. Claim 23 has been cancelled. Claims 1, 3-8, 10-18, 20, 22, and 24-29 will be pending upon entry of this Amendment B. Applicant respectfully requests reconsideration and allowance of all pending claims.

1. Double Patenting

The Office has stated that claims 20, 22, 24, and 27-29 will be objected to under 37 CFR 1.75 as being substantial duplicates of claims 3, 8, and 10-13, respectively, if the latter claims are found allowable. Applicant wishes to address this potential objection at a later time, specifically, when claims 3, 8, and 10-13 have been found allowable. If the Office has any questions or concerns, please contact Applicant's representative, Mr. Christopher M. Goff, at 314-621-5070.

2. Rejection of Claims 1, 3, 6, 8, 12, 14-17, 20, 22, 23, 25, 26, and 28 Under 35 U.S.C. §102(b)

Reconsideration is requested of the rejection of claims 1, 3, 6, 8, 12, 14-17, 20, 22, 23, 25, 26, and 28 under 35 U.S.C. §102(b) as being anticipated by Gabler (U.S. 5,481,758)

Claim 1, as amended herein, is directed to a method of advertising. The method comprises: selling space on a

disposable diaper to a sponsor; and placing an ad for a product other than disposable diapers **onto the disposable diaper**.

Claim 8, as amended herein, is directed to a system for generating advertising revenue comprising: a **disposable diaper**; and an ad for products other than disposable diapers placed **onto the disposable diaper**.

Claim 14, as amended herein, is directed to a method of promoting product purchases. The method comprises: placing a promotion relating to purchasing the product **onto a disposable diaper**; and selling the disposable diaper to a customer.

Claim 22, as amended herein, is directed to a system for promoting product purchases. The system comprises: a **disposable diaper**; and a promotion related to purchasing the products. The promotion is placed **on the disposable diaper**.

Gabler discloses a garment which carries a message in combination with a three-dimensional structure. More particularly, Gabler discloses an article of clothing having a reproduction of paper money, which appears to be protruding from the garment, to attract the attention of a viewer, and a message to be read by the viewer in close proximity to the paper money reproduction. The articles of clothing useful in Gabler can be

outer garments intended to be seen on the wearer in public, such as pocket tee shirts, button shirts, jackets, vests, pants, shorts, and jeans, as well as articles of clothing only normally seen in private, such as novelty children's sleep wear, novelty underwear such as bras, panties, boxer shorts, and night gowns.

Significantly, Gabler fails to disclose applying the paper money reproduction (or any other design or graphic) on a disposable diaper as required in Applicant's claimed invention. This is an important limitation of Applicant's amended claims 1, 8, 14, and 22, and a significant aspect of Applicant's claimed invention.

The Office apparently includes diaper with the articles of clothing and garments as disclosed in Gabler. Applicant respectfully disagrees with the Office as a disposable diaper, as required in Applicant's claimed invention, is not the same as an article of clothing such as a pocket tee shirt or underwear. Specifically, as well known in the art, disposable diapers typically include an absorbent pad, a bodyside liner material/liquid pervious topsheet, and a liquid impervious barrier layer/backsheets. (See, e.g., U.S. Patent Nos. 4,213,459; 6,162,961; 6,659,990; and 7,294,593). The backsheets or liquid impervious barrier layer, which is the material to

which the ad or promotion will be attached, is conventionally made of a breathable film material, and in many embodiments, will have micropores to allow for improved breathability (see, U.S. Patent No. 6,659,990). As such, the outer material of the disposable diaper will have specific characteristics that the system and user of the system must keep in mind and recognize prior to placing the ad or promotion onto the disposable diaper. Specifically, the method of adhering and/or attaching the ad or promotion to the disposable diaper in such a manner as to remain on the diaper for a sufficient time must be kept in mind. Articles of clothing or garments such as the pocket tee shirt of Gabler are not made of breathable films and, thus, the above-mentioned considerations need not be designed around. As such, Gabler simply fails to disclose a method or system of placing an ad or promotion onto a disposable diaper as required in Applicant's claims 1, 8, 14, and 22.

As stated in M.P.E.P. §2131, a claim is anticipated by a reference only if each and every element as set forth in the claim is found, either expressly or inherently described, in the cited reference. As noted above, Gabler fails to disclose each and every limitation of Applicant's claimed invention as Gabler fails to disclose or suggest placing an ad or promotion **onto a**

disposable diaper. As such, claims 1, 8, 14, and 22 are novel over the Gabler reference.

Claims 3-7 depend directly or indirectly from claim 1, and thus are novel over the Gabler reference for the same reasons as claim 1 set forth above, as well as for the additional elements they require.

Claims 10-13 depend directly or indirectly from claim 8, and thus are novel over the Gabler reference for the same reasons as claim 8 set forth above, as well as for the additional elements they require.

Claims 15-18 and 20 depend directly from claim 14, and thus are novel over the Gable reference for the same reasons as claim 14 set forth above, as well as for the additional elements they require.

Claims 24-29 depend directly from claim 22, and thus are novel over the Gable reference for the same reasons as claim 22 set forth above, as well as for the additional elements they require.

3. Rejection of Claims 4, 5, 7, 10, 11, 13, 18, 24, 27, and 29 Under 35 U.S.C. §103(a)

Reconsideration is requested of the rejection of claims 4, 5, 7, 10, 11, 13, 18, 24, 27, and 29 under 35 U.S.C. §103(a) as being unpatentable over Gabler in view of Iwamoto (WO 03/02496).

Claims 4, 5, 7, 10, 11, 13, 18, 24, 27, and 29 depend from claims 1, 8, 14, and 22, respectively, which are discussed above. Claims 1, 8, 14, and 22 are patentable over the Gabler reference for the reasons set forth above; that is, Gabler fails to teach or suggest placing an ad or promotion **onto a disposable diaper**. Iwamoto fails to overcoming this shortcoming.

Specifically, Iwamoto discloses a jacket having two chest pockets, wherein the pockets have an advertisement displayed thereon. The back body of the jacket may also have an advertisement display portion, displaying a commodity, an event or the like. The advertisement(s) may be printed or embroidered directly on the jacket. Alternatively, the advertisement may be detachable from the jacket. Similar, to Gabler, Iwamoto fails to teach or suggest placing an ad or promotion **onto a disposable diaper**.

In order for the Office to show a *prima facie* case of obviousness, M.P.E.P. §2143 requires that the Office must meet

three criteria: (1) the prior art references must teach or suggest all of the claim limitations; (2) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references, and (3) there must be some reasonable expectation of success. An obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of the case. The common sense of those skilled in the art can demonstrate why some combinations would have been obvious where others would not. The Office has clearly failed to meet its burden under numbers (1) and (2) above, as the references, alone or in combination fail to teach or suggest each and every limitation of Applicant's claims 1, 8, 14, and 22 and further, there is no motivation or suggestion to modify the Gabler and/or Iwamoto references to arrive at Applicant's claims.

Specifically, as noted above, neither cited reference teaches or suggests the method of placing an ad or promotion onto a disposable diaper. At best, the references teach placing an ad on an article of clothing such as a pocket tee shirt or jacket. No where, however, is a disposable diaper having the features (e.g., breathable film material and/or micropores) as

well known in the art even mentioned. Furthermore, nowhere in the cited references is the recognition of designing the placement of the ad or promotion onto a breathable film material such as used on the outer layer of disposable diapers ever mentioned. As such, there is simply no reason to modify the Gabler and Iwamoto references to arrive at each and every limitation of Applicant's claimed invention.

Moreover, the common sense of one ordinarily skilled in the art would not have provided a reason to modify the cited references to arrive at Applicant's disposable diaper with an ad and/or promotion placed thereon as required in claims 1, 8, 14, and 22. Specifically, as noted above, disposable diapers include materials such as breathable film materials and/or micropores that are not used in articles of clothing and, as such, why would one skilled in the art be motivated to place their ad or promotion, used on a tee shirt or jacket, onto a disposable diaper? Based on the teachings of the cited references, there is simply no motivation to modify the cited references to arrive at Applicant's instant claims 1, 8, 14, and 22.

As the cited references fail to disclose each and every limitation of Applicant's claims 1, 8, 14, and 22 and, further,

there is no motivation or suggestion to modify the references to arrive at each and every limitation of Applicant's claims, claims 1, 8, 14, and 22 are patentable over Gabler in view of Iwamoto.

Furthermore, as claims 4, 5, 7, 10, 11, 13, 18, 24, 27, and 29 depend directly or indirectly on claims 1, 8, 14, and 22, respectively, claims 4, 5, 7, 10, 11, 13, 18, 24, 27, and 29 are patentable for the same reasons as their respective independent claims set forth above, as well as for the additional elements they require.

Conclusion

In view of the above, Applicant respectfully requests favorable reconsideration and allowance of all pending claims. The Commissioner is hereby authorized to charge any fee deficiency in connection with this Amendment B to Deposit Account Number 01-2384.

Respectfully Submitted,

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